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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92061974
Party	Defendant Balance Studios Inc.
Correspondence Address	BALANCE STUDIOS INC 411A HIGHLAND AVENUE #101 SOMERVILLE, MA 02144 UNITED STATES
Submission	Motion to Suspend for Civil Action
Filer's Name	Heather R. Norton
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Date	08/11/2015
Attachments	Motion to suspend.pdf(352066 bytes)

Attorney for Registrant Balance Studios, Inc.

Cybernet)
Entertainment, Inc.)
)
Petitioner,)
v.) Cancellation No. 92061974
)
)
)
Balance Studios, Inc.)
)
Registrant.

**MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL
ACTION PURSUANT TO TRADEMARK RULE 2.117(a)**

Registrant Balance Studios, Inc. (“Registrant”) hereby moves to stay the above-referenced cancellation proceeding until final determination of the civil action which Registrant filed in the Northern District of California on July 27, 2015.

ARGUMENT

This Cancellation Proceeding should be suspended pending the outcome of a federal district court action between these same parties and involving identical claims. The present Cancellation Proceeding was filed on July 30, 2015. Petitioner argues that Registrant’s Mark should be cancelled because Petitioner is the senior user of the Mark. However, on July 27, 2015, Registrant as Plaintiff filed an action against Petitioner as Defendant in the United States District Court for the Northern District of California, Case No. 3:15-cv-03441-HSG (the “federal court action”) (see true and correct copy of Registrant’s Complaint, attached hereto as Exhibit A). In that action, Registrant alleges violations of the Lanham Act and of California Unfair Competition Law. Registrant’s Lanham Act claims necessarily require the district court to determine which party is the senior user and rightful owner of the Mark at issue.

“To the extent that a civil action in a [f]ederal district court involves issues in common with those in a proceeding before the Board, the decision of the [f]ederal district court is often binding upon the Board.” *See* TBMP § 510.02(a). It is well-established precedent that a decision by a district court would be binding upon the United States Patent and Trademark Office. *Tokaido v. Honda Assocs. Inc.*, 179 U.S.P.Q. 861, 862 (T.T.A.B. 1973). Thus, “[t]he only question for determination . . . is whether the outcome of the civil action will have a bearing on the issues involved in the opposition proceeding.” *Other Tel. Co. v. Conn. Nat’l Tel. Co., Inc.*, 181 U.S.P.Q. 125, 126 (T.T.A.B. 1974), petition denied, 181 U.S.P.Q. 779 (Comm’r

1974).

Here, the final determination of that federal court action will have a bearing on the issues before the Board because both proceedings are between the same parties and involve claims of identical subject matter. Specifically, as stated above, both the Cancellation Proceeding and the federal court action revolve around the validity and ownership of Registrant's Mark. See Exhibit A. In the federal court action, Registrant, as Plaintiff, seeks a finding that Petitioner has infringed Registrant's trademark. That issue necessarily involves the determination of which party is the senior user and rightful owner of the Mark at issue. Thus, there can be no doubt that the final resolution of the federal civil action will be dispositive of the issues in the Cancellation Proceeding. To proceed further with a claim in this forum would waste the resources of this agency, while the federal court is considering identical evidence and arguments on the exact same claims.

In *Rhoades v. Avon Products, Inc.*, 504 F.3d 1151, 1165 (9th Cir. 2007), the Ninth Circuit found that where an action pending before a district court necessarily requires the court to decide issues that are also pending in the TTAB, the district court alone should hear the case. In arriving at that holding, the Ninth Circuit emphasized efficiency as a primary concern. Here, just as in *Rhoades*, the issues before the district court encompass the issue before the TTAB, but are generally broader in scope than the issue before the TTAB. As a result, it would be most efficient to allow the district court to decide the issues of infringement, false designation of origin and unfair competition, which necessarily involves a determination of priority of use, rather than having parallel proceedings on the issue of priority of use and ownership in different tribunals.

CONCLUSION

For the reasons set forth herein, Registrant respectfully submits that it has established good cause for the suspension of this Cancellation Proceeding and requests the granting of its Motion to Suspend Proceeding Pending Disposition of

Federal Civil Action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "H. R. Norton", written over a horizontal line.

Heather R. Norton, Esq.
Attorney for Registrant

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION** was served on counsel for petitioner, this 11th day of August 2015, by sending the same via First Class Mail, to:

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/s/ Heather R. Norton
Attorney for the Registrant

EXHIBIT A

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CHAMBERS COPY

Attorney for Plaintiff Balance Studios, Inc. d/b/a
Kink Academy.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

Balance Studios, Inc., a Delaware
Corporation d/b/a Kink Academy,

Plaintiff,

v.

Cybernet Entertainment, LLC, a California
entity d/b/a Kink.com,

Defendant.

Case No. 3:15-cv-03441

**COMPLAINT FOR DAMAGES AND
INJUNCTIVE RELIEF**

JURY DEMAND

Kink Academy Complaint

1 Plaintiff Balance Studios, Inc. d/b/a/ Kink Academy and KinkAcademy.com (“Kink
2 Academy”) for its Complaint against Defendant Cybernet Entertainment, LLC d/b/a Kink.com
3 (“Kink”) alleges as follows:

4 **INRODUCTION**

5 1. In this action, Kink Academy asserts that Defendant has infringed its trademark and
6 committed acts of unlawful competition. Kink Academy seeks injunctive relief and money
7 damages to remedy the harm caused by Defendant’s unlawful conduct.

8 **THE PARTIES**

9 2. Plaintiff Balance Studios, Inc. d/b/a/Kink Academy is a Delaware Corporation with
10 its primary place of business at 411A Highland Avenue, #101 Somerville, Massachusetts 02144.

11 3. Upon information and belief, Defendant Cybernet Entertainment, LLC d/b/a
12 Kink.com and Kink Studios, LLC among other aliases, is a California Limited Liability
13 Company with its primary place of business at 1800 Mission Street, San Francisco, California
14 94103.

15 **JURISDICTION AND VENUE**

16 4. This action arises under the Lanham Act, 15 U.S.C. §§ 1114 and 1125. This Court
17 has jurisdiction over the claims arising under the Lanham Act pursuant to 28 U.S.C. §§ 1331 and
18 1338. This Court has supplemental jurisdiction over the remaining claims under 29 U.S.C. §
19 1367.

20 5. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 in that
21 Defendant resides in this judicial district and a substantial part of the events or omissions giving
22 rise to the claims herein occurred in this judicial district.

23 6. This Court has personal jurisdiction over Defendant because during all relevant
24 times, Defendant has repeatedly, knowingly, and intentionally directed, and participated in, its
25 activities in this Complaint in this judicial district. While directing, and participating in, the
26 activities alleged in this Complaint, Defendant made systematic and continuous contacts with
27 Kink Academy Complaint – 1

1 this judicial district.

2 **FACTS**

3 7. Kink Academy is a business that offers adult sexual education. Kink Academy offers
4 its services through the KinkAcademy.com website, as well as through workshops and seminars.
5 The KinkAcademy.com website offers a comprehensive library of sexual education videos for
6 adventurous adults. The website also offers a variety of written educational content.
7 KinkAcademy is committed to its mission of offering videos and other content that is educational
8 in nature, and not solely for entertainment purposes.

9 8. Kink Academy is devoted to offering videos and other educational content that
10 fosters confidence and a positive body image in its customers. The Kink Academy team works
11 with sex educators from around the world to present the most diverse and experienced voices
12 possible for ongoing sexual education.

13 9. Kink Academy has developed a strong reputation for integrity and high-quality
14 educational materials within the community of adult sexual educators. Kink Academy has also
15 developed a diverse and loyal customer base.

16 10. The KinkAcademy.com website has been offering adult sexual education materials
17 since 2007, and has been used continually for that purpose.

18 11. Kink Academy owns U.S. Trademark Registration Number 3958399 for the “Kink
19 Academy” word and logo mark (the “Kink Academy Mark”) shown here:



12. The Kink Academy Mark is registered in International Class 041 for adult sexuality education, namely, through workshops, seminars, on-line video classes featuring information on adult role-play, bondage, domination and submission, fetishes and gender exploration designed to enhance couple's intimacy, and acknowledgment of one's own sexuality.

13. The Kink Academy Mark was first used in commerce on February 1, 2007.

14. Kink.com is an adult entertainment website owned and operated by Defendant. The website offers a variety of pornographic videos.

15. On information and belief, on or before November 2014, Kink.com began operating a "Kink University" website, accessible at KinkUniversity.com or Kink.com/KinkUniversity. The Kink University website is a pornography website that purports to offer educational information. The primary purpose of the website is for entertainment.

16. On information and belief, Peter Acworth, who is the owner and founder of Kink signed up to be a member of the Kink Academy website before launching the KinkUniversity.com website.

17. Kink uses a logo that include a stylized "K, and a diploma along with the phrase "Kink University" as shown below:



18. On April 8, 2014, Kink filed a trademark application for the term "Kink University," Serial Number 86246402.

19. Kink's trademark application lists a date of first use in commerce of April 1, 2014.

20. Kink's trademark application is for use of the "Kink University" mark in International Category 041 for Education services, namely, providing live and on-line classes, panel discussions, tutorials, seminars, and workshops in the field of sexuality.

21. On July 23, 2014, the Trademark Office issued an Office Action, in which it rejected Kink Academy Complaint – 3

1 Kink's application in view of the previously registered Kink Academy Mark. The Trademark
2 Office found that consumer confusion would exist between "Kink Academy" and "Kink
3 University."

4 22. Kink failed to respond to the Office Action, and its trademark application was
5 deemed abandoned on February 20, 2015.

6 23. Kink subsequently filed a motion to revive the application. The Trademark Office
7 did revive the application. On April 14, 2015, the Trademark Office issued a final rejection in
8 which it maintained its rejection of Kink's application in view of the Kink Academy Mark. The
9 Trademark Office reiterated that the two marks convey a similar commercial impression and the
10 use of "Kink University" would likely cause consumer confusion with the "Kink Academy"
11 Mark.

12 24. Despite the Trademark Office's ruling, Kink continues to infringe Kink Academy's
13 Mark.

14 25. On information and belief, Defendant's "Kink University" website is designed to
15 take advantage of the significant name recognition and goodwill surrounding Kink Academy and
16 its products.

17 26. Defendant is damaging the public by causing confusion between Kink Academy and
18 Kink University. As a result of Defendant's actions, Kink Academy has suffered monetary
19 damage in the form of diverted traffic and lost sales. Defendant is damaging the valuable
20 reputation and goodwill in the Kink Academy brand by marketing pornography videos under the
21 guise of educational videos.

22 27. Actual confusion has already occurred between Kink Academy and Kink University,
23 and is likely to keep occurring unless Kink is enjoined from using the "Kink University" logo
24 and phrase. Kink Academy's brand and its reputation for integrity and high-quality educational
25 materials have been damaged by being associated with Kink's pornography videos.

COUNT I – TRADEMARK INFRINGEMENT
(15 U.S.C. § 1114)

28. Plaintiff realleges and incorporates by reference, as if fully set forth herein, the allegations in all the preceding paragraphs.

29. Plaintiff owns U.S. Trademark Registration 3958399 for the “Kink Academy” word and logo mark.

30. Defendant uses a confusingly similar logo and phrase to market adult videos and to draw traffic to its websites.

31. Defendant’s use of the “Kink University” mark is without the permission of Plaintiff.

32. Defendants’ use of its “Kink University” mark in interstate commerce constitutes a reproduction, counterfeit, copy, or colorable imitation of a registered trademark of Plaintiff in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use has caused confusion, mistake, or to deception, and will continue to do so. Users of Defendants’ products are likely to be confused as to whether Defendants’ products are associated with or approved by Plaintiff.

33. If Defendant’s conduct is permitted to continue, Plaintiff faces the risk of irreparable harm. Plaintiff’s remedy at law is not by itself adequate to remedy Defendant’s actions, and irreparable harm suffered by Plaintiff will continue unless this Court enjoins Defendant. Plaintiff is therefore is entitled to injunctive relief.

34. Furthermore, Plaintiff is informed and believes, and on that basis alleges, that the actions of Defendant were undertaken willfully and with the intention of causing confusion, mistake, or deception, making this an exceptional case entitling Plaintiff to recover reasonable attorneys’ fees and treble damages pursuant to 15 U.S.C. § 1117.

COUNT II – FALSE DESIGNATION OF ORIGIN
(15 U.S.C. § 1125(a))

36. Plaintiff realleges and incorporates by reference, as if fully set forth herein, the

Kink Academy Complaint – 5

1 allegations in all the preceding paragraphs.

2 37. As a result of Plaintiff's widespread use of its Kink Academy Mark, its Mark has
3 achieved substantial goodwill, recognition and reputation throughout the United States.

4 38. Defendant's unauthorized use of the name "Kink University" constitutes use in
5 commerce of a word, term, name, symbol, or device or a combination thereof, constituting a
6 false designation of origin, a false and misleading deception, and a false and misleading
7 representation that is likely to cause confusion, mistake, or deception as to the affiliation,
8 connection or association of Defendant with Plaintiff, and further is likely to cause confusion,
9 mistake or deception as to the origin, sponsorship or approval by Plaintiff of Defendant's use of
10 the Kink University phrase.

11 39. These acts by Defendants constitute a violation of § 43(a) of the Lanham Act, 15
12 U.S.C. § 1125(a).

13 40. As a result of Defendant's actions, Plaintiff has suffered injury, including irreparable
14 injury, and damages, including lost profits, reasonable royalties, and other damages as set forth
15 herein.

16 **COUNT III – UNFAIR COMPETITION**
17 **(Cal. B&P Code §§ 17200 and 17500 et seq.)**

18 35. Plaintiff realleges and incorporates by reference, as if fully set forth herein, the
19 allegations in all the preceding paragraphs.

20 36. The acts and practices of Defendant as alleged herein, including without limitation,
21 Defendant's use of the "Kink University" phrase to market and promote its products, constitutes
22 false advertising, and unfair competition in violation of the laws of the state of California. As a
23 result, Plaintiff has suffered and will continue to suffer damage to its business, reputation, and
24 goodwill.

25 37. As a direct and proximate result of Defendant's willful and intentional actions,
26 Plaintiff has suffered damages in an amount to be determined at trial.

38. Unless Defendant is restrained from pursuing its unlawful course of conduct, Plaintiff will continue to suffer irreparable harm. Plaintiff is therefore entitled to injunctive relief.

PRAYER FOR RELIEF

THEREFORE, Plaintiff Kink Academy prays for judgment against Defendant as follows:

A. An award of Defendant's profits from its infringement and unfair competition with Plaintiff;

B. An award of Plaintiff's damages caused by Defendant's infringement and unfair competition with Plaintiff;

C. An injunction against Defendant and each of its agents, servants, employees, and attorneys, and those persons in active concert or participation with it:

(1) Enjoining the use of the Kink University word and logo mark, or any colorable imitation thereof or confusingly similar term, in the adult entertainment and/or sexual education market;

(2) Requiring the immediate removal of the "Kink University" word and logo mark from all websites owned or controlled by the enjoined parties, including but not limited to, www.kink.com, www.kinkuniversity.com, and www.kink.com/kinkuniversity.com, and all other text or media offering for sale any products making infringing use of the designations and content.

D. An award of Plaintiff's attorneys' fees, expenses, and costs; and


E. Awarding treble damages in the amount of Defendant's profits or Plaintiff's damages, whichever is greater, for willful infringement pursuant to 15 U.S.C. 1117(b);

F. Such further relief as the Court deems just and reasonable.

JURY TRIAL DEMAND

Plaintiff hereby demands a trial by jury on all issues so triable in this action.

1 DATED: July 27, 2015

2 By: 
3 Heather R. Norton
4 Law Office of Heather Norton
5 Attorney for Plaintiff Balance Studios, Inc.
6 d/b/a Kink Academy
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27 Kink Academy Complaint – 8
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